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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/741,828	12/19/2003	Jack T. Baker	9687-4 CII (37786-188947)	6165
23973	7590	12/21/2005	EXAMINER	
DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			HUG, ERIC J	
			ART UNIT	PAPER NUMBER
			1731	
DATE MAILED: 12/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/741,828	Applicant(s) BAKER, JACK T.	
	Examiner Eric Hug	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-22 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-19 is/are rejected.
- 7) ☒ Claim(s) 3 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4, 7, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearer (US 6,165,323) in view of Aaltonen et al (WO 93/07334) and Andersson (US 6,284,145).

Shearer teaches a screen panel (plate) for the separation of liquor from wood chips in a wood digester. The screen has a plurality of angled slots (Figures 2 and 3) having a width in the range of from 3 to 10 mm (see column 2, line 21 for a slot width of 2-13 mm). See Figures 2 and 3 for a slot length of 1.5 to 3 inches (18 = 1 inch, 19 = 2 inches and 20 = 2 inches, column 3, lines 42-55). See Figure 5 for width widens outward at an angle of 30 to 60 degrees or a half angle of 15 to 30 degrees, and Figure 16 for a slot having a parallel-sided portion and a widening portion. Shearer discloses straight, angled slots rather than the claimed curved slots.

Aaltonen shows in the Figures several alternate shapes for the screen slots, including the claimed curved slots and including straight slots shaped and oriented like those in Shearer. Aaltonen also discloses wavy slots shaped like those in Andersson (see below). Thus, different slot shapes at the very least appear to be known alternatives to one another.

Andersson is cited here to present distinct advantages of using curved or wavy slots over straight slots for separation of comparatively coarse contaminants from pulp suspensions. The width of the slots is dimensioned such that the fibers pass through the screen slots while the coarse contaminants are hindered. The slots are curved to obtain a good separation efficiency. Separation of coarse contaminants such as shives is particularly improved. In screens having straight slots or holes, shives may pass through the screen slots if they are oriented along the same. Thus, Andersson teaches that separation of shives from a pulp suspension is considerably increased in screen with curved or wavy slots in comparison with known screen plates having slots or holes of other known geometries. Note that Andersson cites reference WO 93/07334 (Aaltonen) as teaching curved screen slots. Thus, better than expected results using curved slots over straight slots is disclosed by Andersson, and therefore it would have been obvious to one skilled in the art to use curved slots instead of the angled slots in the digester of Shearer to obtain the advantages thereof.

The claimed slot widths are disclosed by Shearer for straight slots and it would have been obvious to use the same widths for curved slots so that the curved slots are applicable for a digester, where larger wood chips are encountered. Any departure of the slot width in the claims from that disclosed by Shearer does not impart patentability to the claims. The Federal Circuit's predecessor court, the CCPA, has repeatedly held that presumption of obviousness was formed, based on the ken of routineer, whenever a difference was deemed minor. *In re Rose*, 105 USPQ 237 (CCPA 1955), it was held that the size of an article is not a matter of invention.

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2. Claims 9-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shearer (US 6,165,323) in view of Aaltonen et al (WO 93/07334) and Andersson (US 6,284,145) as applied to claim 1 above, and further in view of Beuermann et al (US 5,638,960).

It would also have been obvious to have the slots widen at one or more surfaces for increased throughput and reduced clogging of the slots. The use of slots with one widened surface is exemplified by Shearer and also by Aaltonen (see Figures 6a and 6b; page 14, line 22). As it would have been obvious to have the slots widen at one or more surfaces for increased throughput and reduced clogging of the slots, it would also have been obvious to use of slots with two widened surfaces for the same reasons as exemplified by Beuermann. Beuermann discloses, in particular, slots having a constant cross-section in the middle portion (see Figure 3 and column 3, lines 32-38). Any departures in the shape of the slots of the present invention from those disclosed by the above references would have been obvious modifications to optimize the throughput and screening capability while minimizing clogging.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shearer (US 6,165,323) in view of Aaltonen et al (WO 93/07334) and Andersson (US 6,284,145) as applied to claim 1 above, and further in view of Chupka (US 4,795,560).

In Shearer and Aaltonen above, the slots are all oriented in the same direction. Chupka teaches the use of curved screen slots in a pulp screen plate, and in particularly discloses all the curved screen slots having the concave portions oriented in one direction. Thus, it would have been obvious to one skilled in the art to arranged curved slots accordingly.

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Note that the feature of "arranged to be installed in a digester with that direction being the upstream direction of chip flow" is a statement of intended use, and thus has not been given patentable weight with respect to the claimed screen panel.

Double Patenting

Applicant is advised that should claims 9 and 11 (or alternatively claims 17 and 18) be found allowable, claims 17 and 18 (or alternatively claim 9 and 11) will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 2, 4, 5, 7-11, 13, 14, and 17-19 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-14 of copending Application No. 10/193,500. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Allowable Subject Matter

Claims 20-22 are allowed.

Claims 3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 5 are allowable over the prior art, but have been rejected on the ground of nonstatutory double patenting given above.

The following is a statement of reasons for the indication of allowable subject matter:

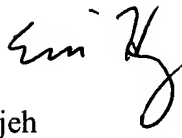
The claims are allowable for further providing one or more of the chord length and the radius of curvature. Such design features are not obvious from the teachings of the applied prior art.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is 571 272-1192. The examiner can normally be reached on Monday through Friday, 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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